

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1-17 were pending in this application, with claim 17 withdrawn from consideration after a preliminary election in a telephone restriction. In this response, claims 1-4, 6, and 9-16 have been amended. Thus, claims 1-17 (claim 17 withdrawn) remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification , paragraph [0017].

ELECTION/RESTRICTION REQUIREMENT

In response to the Restriction Requirement forwarded by the Official Action dated December 15, 2005, Applicants hereby provisionally elect Group I, including Claims 1-16 (drawn to a product) for prosecution in the above-identified application. This election is made with traverse.

It is respectfully submitted that the subject matter of claims 1-17 is sufficiently related that a thorough search for the subject matter of any one group would necessarily encompass a search for the subject matter of the remaining groups. Thus, it is respectfully submitted that the search and examination of the entire application could be performed without serious burden. MPEP §803 clearly states that "If the search and

examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants in duplicative examination by the Patent Office.

The Examiner is respectfully requested to reconsider and withdraw the Restriction Requirement and to examine claims 1-17 in this application.

Should any questions arise in connection with this application, the undersigned respectfully requests that he be contacted at the number indicated below.

DOUBLE PATENTING REJECTION

Claims 1-16 stand provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as claims 1-16 in U.S. Application No. 10/807,341. This rejection is respectfully traversed.

Contrary to the position in the Official Action, the present claims 1-16 do not in fact claim the same invention as that in claims 1-16 in U.S. Application No. 10/807,341. For example, claim 1 of U.S. Application No. 10/807,341 differs from claim 1 of the present application (the only independent claim at issue here) in both the cobalt content and the amount of cubic carbonitride forming elements. Other examples, include claim 2 (different amounts of cobalt and cubic carbonitride forming elements), claim 3 (different thicknesses of the layer of $\text{TiC}_x\text{N}_y\text{O}_z$), claim 9 (different S-value and mean intercept length), and claim 10 (different S-value and mean intercept length). Finally,

amended claim 1 has a layer of α -Al₂O₃, while . Application No. 10/807,341 claims Al₂O₃.

Thus, because the present claims 1-16 are, in fact, different from claims 1-16 of U.S. Application No. 10/780,681, the rejection is respectfully traversed and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1-16 stand rejected under 35 U.S.C. §102(a) as being anticipated by European Patent Application No. 1 205 569 to Sandvik (hereafter "*Sandvik*") on the grounds set forth on page 4 of the Official Action. To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. Here, the rejection is traversed because the cited reference does not teach every element of at least claim 1, the only independent claim at issue here.

Specifically, *Sandvik* does not disclose the claimed Al₂O₃ layer. For example, *Sandvik* discloses a κ -Al₂O₃ layer (abstract and page 3, line 31). In contrast, claim 1 claims an α -Al₂O₃ layer. In light of at least this difference, Applicants respectfully submit that an anticipatory rejection is improper since *Sandvik* does not disclose the invention as claimed.

Claims 1-16 stand rejected under 35 U.S.C. §102(e)¹ as being anticipated by U.S. Patent No. 6,406,224 to Ostlund et al. (hereafter "*Ostlund et al.*") on the grounds set forth on page 4 of the Official Action. To anticipate a claim, the reference must

teach every element of the claim. See MPEP § 2131. Here, the rejection is traversed because the cited reference does not teach every element of at least claim 1, the only independent claim at issue here.

Specifically, *Ostlund et al.* does not disclose the claimed Al_2O_3 layer. For example, *Ostlund et al.* discloses a smooth $\kappa\text{-Al}_2\text{O}_3$ layer (col. 2, line 45 and col. 3, line 47). In contrast, claim 1 claims an $\alpha\text{-Al}_2\text{O}_3$ layer. In light of at least this difference, Applicants respectfully submit that an anticipatory rejection is improper since *Ostlund et al.* does not disclose the invention as claimed.

Claims 1-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,200,671 to Lindskog et al. (hereafter "*Lindskog et al.*") on the grounds set forth on page 4 of the Official Action. To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. Here, the rejection is traversed because the cited reference does not teach every element of at least claim 1, the only independent claim at issue here.

Specifically, *Lindskog et al.* does not disclose the claimed Al_2O_3 layer. For example, *Lindskog et al.* discloses a fine-grained $\kappa\text{-Al}_2\text{O}_3$ layer (abstract, col. 2, line 44 and col. 3, line 24). In contrast, claim 1 claims an $\alpha\text{-Al}_2\text{O}_3$ layer. In light of at least this difference, Applicants respectfully submit that an anticipatory rejection is improper since *Lindskog et al.* does not disclose the invention as claimed

¹ *Ostlund et al.* qualifies as prior art, if at all, not under 102(e) but rather under 102(a).

In addition to the above, Applicants note that the cited documents also do not disclose all of the features of each of the dependent claims. For example, one or more of the references does not disclose a Al_2O_3 layer with a thickness of 3 to 10 μm (claim 2) and is also silent as to mean intercept length (claim 9-10). Other features not disclosed in one or more of the references include nitrogen present in the sintered body in claimed amounts (claim 12) and the claimed ratios of tantalum and niobium and titanium and niobium (claims 15-16).

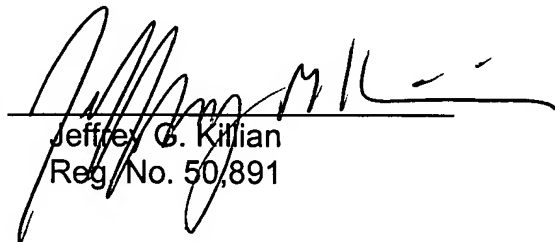
CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

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By: 
Jeffrey G. Killian
Reg. No. 50,891

CUSTOMER NO. 055694
DRINKER, BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209
Tel: (202) 842-8800
Fax: (202) 204-0289